

REMARKS

All pending claims are canceled, which include 7, 8a, 8b, 9-15 and 20-21. New claims 23-30 correspond to canceled claims 9-11, 13-15 and 20-21, respectively. New claim 22 corresponds to renumbered claim 8b with the limitations of canceled claim 12 included.

Claims 22-27 and 29 stand rejected under 35 U.S.C. §102(b) as being anticipated by May (Re 29,630). Claims 23-25, 28 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over May in view of Srinivasan (6,309,987).

Regarding the anticipation rejection (§102) against claim 22 based on May, such claim recites a first nonwoven of natural fibers or synthetic fibers and a second nonwoven of natural or synthetic fibers. Referring to rejections under 35 U.S.C. §102, the MPEP and Federal Circuit Court provide that §102 anticipation requires that *each and every element* of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990); MPEP §2131 (8th ed.). The corollary of this rule is that the absence from a cited §102 reference of *any* claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). May fails to teach two nonwoven fabrics, and an electronic search to the document verifies the same. May teaches a mattress of “desired and well known construction” ... “as comprising an encasing ticking fabric filled with batting” (col. 4, Ins. 60-64) and “the batting maybe rayon or other natural

or synthetic material while the ticking is usually woven cotton fabric" (col. 4, Ins. 65-69). The Examiner relies on this teaching to the cotton mattress ticking as the "first non-woven" recited in claim 22 (pg. 3 of paper no. 2), contrary to the explicit inapposite teachings of May. That is, May clearly teaches such cotton mattress ticking **is woven**. Accordingly, in no fair or reasonable interpretation does a teaching to a woven cotton fabric teach or suggest a **nonwoven** fiber. Consequently, May fails to teach or suggest a first nonwoven fiber **and a second nonwoven** fiber as recited in claim 22. Pursuant to the above authority, since May fails to teach or suggest a positively recited limitation of claim 22, the anticipation rejection fails and should be withdrawn. Claim 22 is allowable.

Moreover, claim 22 recites discrete flakes of expanded graphite as a flame-retardant material, which are applied to at least one of the surfaces of the two nonwovens, **and** wherein a membrane permeable to water vapor and air is arranged between one of the two nonwovens and the flakes of expanded graphite. That is, claim 22 recites to two elements, discrete flakes of expanded graphite **and** a membrane arranged between one of the two nonwovens and the flakes. However, the Examiner relies on May's teachings (col. 1, Ins. 63-68 and col. 2, Ins. 1-2) to a coating of film-forming polymeric or resinous binder containing leafing-grade conductive graphite, that is, a singular element, as teaching the two elements recited in claim 22 (pg. 3 of paper no. 2). In no fair or reasonable interpretation does the resinous binder containing leafing-grade

conductive graphite teach or suggest discrete flakes of expanded graphite **and** a membrane as recited in claim 22. Moreover, it is inconceivable that the single coating of May could teach or suggest a membrane arranged **between** one of the two nonwovens and the flakes of expanded graphite because the coating of May could not be arranged between itself. Such is additional evidence that May fails to teach the recited limitations of claim 22. For this additional reason, May fails to teach or suggest a positively recited limitation of claim 22, and therefore, claim 22 is allowable.

Additionally, no combination of art, including Srinivasan, teaches such limitations of claim 22, and therefore, an obviousness rejection against claim 22 based on such combination of art would be inappropriate.

For the above reasons, claim 22 is allowable over May, singularly or in any combination of the cited art, and therefore, claim 22 is allowable. Applicant respectfully requests allowance of claim 22 in the next office action.

Claims 23-26 depend from independent claim 22, and therefore, are allowable for the reasons discussed above with respect to the independent claim, as well as for their own recited features which are not shown or taught by the art of record.

Regarding the anticipation rejection against claim 29 based on May, such claim recites a first nonwoven and a second nonwoven. As stated previously regarding claim 22, May teaches a mattress ticking is usually woven cotton fabric" (col. 4, lns. 65-69). Accordingly, in no fair or reasonable interpretation

does a teaching to a woven cotton fabric teach or suggest a **nonwoven**. Consequently, May fails to teach or suggest a first nonwoven **and a second nonwoven** as recited in claim 29. Since May fails to teach or suggest a positively recited limitation of claim 29, pursuant to the above authority, the anticipation rejection fails and should be withdrawn. Claim 29 is allowable.

Additionally, no combination of cited art, including Srinivasan, teaches such limitations of claim 29, and therefore, an obviousness rejection against claim 29 based on any combination of the cited art would be inappropriate.

For the above reasons, claim 29 is allowable over May, singularly or in any combination of the cited art, and therefore, the rejection against claim 29 is inappropriate and must be withdrawn. Applicant respectfully requests allowance of claim 29 in the next office action.

Claim 30 depends from independent claim 29, and therefore, is allowable for the reasons discussed above with respect to the independent claim, as well as for its own recited features which are not shown or taught by the art of record.

Regarding the obviousness rejection against claims 23-25, 28 and 30 based on the combination of May and Srinivasan, such combination is improper, and therefore, the obviousness rejection fails.

First, the Examiner relies on May as the primary reference to allegedly teach a first **and second** nonwoven (pg. 4 of paper no. 2). As is clearly demonstrated previously, May does not teach two nonwovens, and therefore, the

obviousness rejection must fail. For at least this reason, claims 23-25, 28 and 30 are allowable over the combination of art.

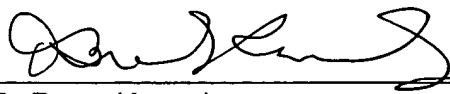
Additionally regarding claims 23-25, the Examiner presents an alleged motivational rationale for the combination stated as, it would be obvious to modify the May invention by teachings of Srinivasan for purpose to create a flame retardant fabric with high thermal stability in the May invention (pg. 4-5 of paper no. 2). However, the Examiner is reminded that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP §2143.01 (8th edition) *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). "Preferably the Examiner's explanation should be such that it provides that impetus necessary to cause one skilled in the art to combine the teachings of the references to make the proposed modification." *Ex Parte Levengood*, 28 USPQ2d, 1300, 1301, Footnote 2, (Bd. Pat. App. and Inter. 1993) (citations omitted). The Examiner is suggesting modifying the May invention to create a flame retardant fabric. However, May explicitly teaches the principle object of its invention is "to provide mattress fabric or the like which is resistant to burning by lighted cigarettes (col. 1, Ins. 59-62). Consequently, May already provides an invention that creates a flame retardant fabric, and therefore, one skilled in the art would not look to Srinivasan for the same redundant teachings. That is, pursuant to the above

authority, the Examiner's explanation **does not provide that impetus necessary** to cause one skilled in the art to combine the teachings of the references to make the proposed modification. Consequently, the motivational rationale for the combination of art fails, and therefore, the obviousness rejection fails. Claims 23-25 are allowable for this additional reason.

In view of the foregoing, allowance of all pending claims is requested. This application is now believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: 2-24-03

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Inventor Gerd Hexels
Assignee Texplorer GmbH
Group Art Unit 1771
Examiner J.A. Boyd
Attorney's Docket No. LO24-001
Title: Garment, In Particular Undergarment, for Persons In Military and Civil Defense
Services

**VERSION WITH MARKINGS TO SHOW CHANGES MADE
ACCOMPANYING RESPONSE TO NOVEMBER 22, 2002 OFFICE ACTION**

The replacement specification paragraphs incorporate the following amendments. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

In the Claims

The claims have been amended as follows. Underlines indicate insertions and ~~strikeouts~~ indicate deletions.

Claims 7, 8a, 8b, and 9-21 have been canceled.

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